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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,130

06/27/2007

Seiichi Toki

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22918

7590

02/25/2008

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EXAMINER

WORLEY, CATHY KINGDON

ART UNIT

PAPER NUMBER

1638

MAIL DATE

DELIVERY MODE

02/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/594,130	Applicant(s) TOKI, SEIICHI	
	Examiner CATHY K. WORLEY	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/25/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Restriction/Election

1. Claims 1-6 are pending in the instant application and are examined in this Office Action.

Specification

2. The abstract of the disclosure is objected to because the first ten words of the abstract are not a complete sentence. Correction is requested. See MPEP § 608.01(b).

Claim Objections

3. Claims 1-6 are objected to because of the following informalities:
 - In claim 1, the comma in line three after “Agrobacterium” should be deleted to be grammatically correct.
 - Claims 2-6 do not use a proper article for a dependent claim; the Applicant is advised to replace “A” with - - The - - .

Appropriate correction is requested.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al (JP2001029075, published on Feb. 6, 2001). The Examiner relies on a machine translation of this document in order to make this rejection.

The claims are drawn to a method for transforming a monocotyledon by infecting a seed with Agrobacterium.

Tanaka et al teach a method for transforming a rice seed comprising the steps of incubating the seed in a medium containing 2 mg/l of 2,4-D for five days followed by cocultivation with Agrobacterium (see paragraphs 0037 - 0039). They claim transformation with Agrobacterium containing a desired recombination gene (see claim 1).

Tanaka et al do not teach pre-culture for 1 to 3 days.

The only difference between the claimed invention in the instant application and the invention taught in the prior art Japanese application is the number of days of pre-culture for the seeds prior to cocultivation with Agrobacterium. In the absence of any showing of unexpected results, it would be an obvious variant of the prior art invention to reduce the number of days of pre-culture. The Japanese plant claims a method using four or five days of pre-culture (see claim 2), and this indicates that the 5-day incubation period in the working example is not critical.

One of ordinary skill in the art would be motivated to try shorter pre-culture times in order to expedite the procedure.

If the Applicant believes the 1 to 3 day pre-culture period provided a surprising and unexpected advantage over the 4-5 day pre-culture period taught in the prior art, then they are invited to provide evidence of such surprising and unexpected results in the form of a declaration.

5. No claim is allowed.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cathy K. Worley whose telephone number is (571) 272-8784. The examiner is on a variable schedule but can normally be reached on M-F 10:00 - 4:00 with additional variable hours before 10:00 and after 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cathy K. Worley/
Examiner, Art Unit 1638
CKW